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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,896	05/23/2000	Jason B. Thomas	1766.0020000	4511

7590 09/28/2004

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EXAMINER

DUONG, OANH L

ART UNIT PAPER NUMBER

2155

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/576,896	Applicant(s) THOMAS ET AL.	
	Examiner Oanh L. Duong	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-19 are presented for examination.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/08/2004 has been entered.

Response to Arguments

2. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

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be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 7-15, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barney (US 6,289,341 B1) in view of Kirsch (US 5,659,732).

Regarding claims 1 and 14, Barney teaches a method comprising:

collecting page that are commonly transmitted over a computer network (i.e., col. 1 lines 59-65);

receiving a list of predetermined, entity-specific criteria defining information relevant to the entity (i.e., col. 4 lines 48-67 and lines 61-67);

receiving a first set of rules related to entity-specific criteria defining information relevant to an entity (col. 5 lines 19-31);

determining whether each of said page satisfies each of said first set of rules therefore obtaining a first subset of said pages (col. 4 lines 48-60);

parsing content of said first subset of said pages using a second rules inclusive of said first set and adding rules related to searching for at least one key word in at least one predetermined category of key words, thereby obtaining a second subset of said pages (col. 5 lines 1-18 and col. 5 lines 49-52); and

generating a report (e.g., see col. 5 lines 49-56).

Barney does not explicitly teach scoring and prioritizing as claimed.

Kirsch, in the same field of endeavor, teaches scoring pages utilizing a set of rules incorporating analyzed statistics and incorporating additional information and prioritizing the results (col. 3 lines 56-61). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized

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scoring and prioritizing steps of Kirsch in the process of identifying intellectual property infringement issues in computer network sites in Barney because such scoring and prioritizing would enable the search results to be scored and ranked based upon their weighted scores, thereby allowing output to be presented in efficient and effective manner.

Regarding claims 2-4 and 15, Barney-Kirsch teaches computer network is the global network, or an intranet or extranet (Barney, Fig. 1).

Regarding claims 7, 8, 18 and 19, Barney-Kirsch teaches compiling statistics from said pages, storing said statistics, and analyzing said statistics by combining said statistics, said pages and said additional information (Kirsch, col. 3 table 1 and lines 51-61).

Regarding claim 9, a system of claim 9 has a corresponding method of claim 1; therefore, claim 9 is rejected under the same rationale as applied to claim 1.

Regarding claims 10-12, Barney-Kirsch teaches the global Internet, an intranet, or extranet (Barney, see fig. 1).

Regarding claim 13, Barney-Kirsch teaches a plurality of Web clients that provides a graphical user interfaces (Barney, col. 1 lines 40-50).

4. Claims 5-6 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barney (US 6,289,341 B1) in view of Kirsch (US 5,659,732) in further view of Davies et al. (Davies) (US 5,931,907).

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Regarding claims 5 and 16, Barney-Kirsch does obtaining contact information for said report.

Davies teaches obtaining contact information for said report (see col. 7 lines 51-60). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the contact information of Davies in the process of generating report in Barney-Kirsch because such contact information would allow the user to access information by a much richer set of meta-information.

Regarding claims 6 and 17, Barney-Kirsch-Davies teaches generating the report listing the scores of each of subset of pages (Davies, col. 5 lines 44-60).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oanh L. Duong whose telephone number is (703) 305-0295. The examiner can normally be reached on Monday- Friday, 8:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (703) 308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

O.D
September 23, 2004



HOSAIN ALAM
SUPERVISORY PATENT EXAMINER